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Utility Patent
Ser. No. 10/799,894

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-7 were pending. Claims 1, 3, 4 and 7 have been amended. Claim 2 has been canceled without prejudice. For the reasons set forth below in part I, Claims 1 and 3-7 are considered patentably distinct over the prior art cited, and therefore are allowable.

New Claims 8-19 have been added. For the reasons set forth below in part II, Claims 8-19 are considered patentably distinct over the prior art cited, and therefore are allowable.

The examiner objected to the drawings for failing to show slots on the proximal end of the handle and locking pins on the proximal end of the arm. Corresponding to this objection, the examiner rejected Claims 3-7 under 35 U.S.C. § 112, Second Paragraph, for indefiniteness stemming from the lack of clarity in Claims 3 and 4. Claims 3 and 4 have been amended to clarify the arrangement of the slots and the pins. As amended, Claim 3 recites limitations of the extension arm described in Claim 1, wherein the extension arm comprises "a cylindrical receiving cavity formed at a distal end of said arm, said cavity for receiving a proximal end of said handle; a pair of opposing receiving slots formed circumjacent said cavity, said slots for receiving and impinging guide locking pins formed at a proximal end of said handle." Thus, the extension is described as having a pair of slots formed circumjacent to a cavity, both formed at the *distal* end of the arm, the slots for engaging locking pins formed at the *proximal* end of the handle. This description accurately describes the relationship of the handle and the extension arm for coupling the two portions together. Likewise, and as amended, Claim 4 recites "guide locking pins formed at a proximal end of said

handle." Thus, the combination of Claim 3 and Claim 4, as presently amended, accurately describe the handle as having locking pins at the proximal end of the handle, and an extension arm having slots for engaging the locking pins, the slots formed at the distal end of the arm. Because of the amendment, clarifying this relationship, withdrawal of the objection to amend the drawings and the rejection for indefiniteness is respectfully requested.

I. In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(a), § 102(b) or § 102(e), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Each and every element of the claimed invention must be disclosed in a single prior art reference "arranged as in the claim." Lindemann Maschinenefabrik GmbH v. American Hoist & Derrick Co., 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984).

As amended, Claim 1 recites (quoting for convenience):

1. A hand held duster comprising:
 - a handle;
 - a duster head removably attached to a distal end of said handle;
 - an internal battery and motor housed within an internal compartment of said handle electrically coupled to a control for actuating operative control of said duster; and
 - an extension arm removably attachable to said handle.

Thus, Claim 1 recites a hand held duster having a handle, a duster head removably attachable to the handle, electrical coupling of a battery, motor and a control for operating the duster, and an extension arm removably attachable to the handle. References Dolah, Sandt and Park each fail to disclose an extension arm removably attachable to the handle. As such, each reference (Dolah, Sandt and Park) fails to disclose every element of Claim 1, and each reference fails to disclose every element as arranged in Claim 1. Thus, Claim 1 is patentably distinct over each reference (Dolah, Sandt and Park). Withdrawal of this rejection is respectfully requested.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(i).

The following combinations of references were cited as disclosing all the elements of Claims 2-5: Dolah in view of Henson; Dolah in view of Lester; Sandt in view of Henson; Sandt in view of Lester; Park in view of Henson; and Park in view of Lester. However, each combination fails, because there is no suggestion, teaching and motivation to combine the series of references as arranged. For the reasons cited below, and specifically, the failure of the references to provide the proper suggestion, teaching and motivation to combine the references, Claims 3-5 are patentably distinct over the combination of references cited. Claim 2 has been canceled without prejudice, and the subject matter of Claim 2 incorporated into the subject matter of amended Claim 1, thus any reference to former Claim 2 and the subject matter formerly contained therein, implicitly refers to Claim 1, as amended and incorporating the subject matter of former and now canceled Claim 2.

Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so.” (Emphasis Added). MPEP § 2143.01, citing In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). Likewise, as referenced in MPEP § 2143.01, citing to In re Fritch, the Federal Circuit stated “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992). (Emphasis Added). Thus, the prior art references must provide the suggestion or motivation for combining the teachings to render the modification obvious.

Dolah, as cited in combination with both Henson and Lester, fails to provide the suggestion and motivation to combine with other references to teach the modification claimed in Claim 1. Dolah recites a rotary brush cleaning device, but fails to disclose the desirability of providing an extension to the handle, in general, or pins for engaging the slots formed on an extension, specifically. It is clear from the specification and claims that the Dolah device provided no suggestion of an extension for the handle, considering that the rotary brush cleaning system was claimed as having brush attachments for toilet cleaning (Claim 11), bottle cleaning (Claim 13), and a baby bottle nipple cleaning attachment (Claim 15), in particular. These specifically claimed attachments, as coupled to the rotary brush, but hinder the intended function of the device - a user would have no need, or desire, for an extension on the handle to clean a toilet, a bottle or a bottle nipple. As such, and at best, Dolah is silent as to suggesting a combination with either Henson or Lester, and arguably, Dolah teaches away from the use of an extension as indicated above in relation to the toilet, bottle and nipple brush attachments. For

these reasons, Dolah does not suggest the combination as cited, thus Claim 1 (as embodying the subject matter of former and now canceled Claim 2) is patenably distinguishable over the combinations of Dolah in view of Henson, and Dolah in view of Lester. Claims 3-7 directly or indirectly depend from independent Claim 1, and as such, are also patentably distinguishable over the combinations of Dolah in view of Henson, and Dolah in view of Lester. Withdrawal of this rejection is respectfully requested.

Sandt, as cited in combination with both Henson and Lester, fails to provide the suggestion and motivation to combine with other references to teach the modification claimed in Claim 1. Sandt recites a portable cleaning device, but fails to disclose the desirability of providing an extension to the handle, in general, or pins for engaging the slots formed on an extension, specifically. The specification provide no indication that the inventor desired an extension for the handle. And, the specification provides no indication that the inventor envisioned pins formed at the proximal end of the handle for engaging slots formed on the extension. Sandt is silent on the desire of such a modification. For these reasons, Sandt does not suggest the combination as cited, thus Claim 1 (as embodying the subject matter of former and now canceled Claim 2) is patenably distinguishable over the combinations of Sandt in view of Henson, and Sandt in view of Lester. Claims 3-7 directly or indirectly depend from independent Claim 1, and as such, are also patentably distinguishable over the combinations of Sandt in view of Henson, and Sandt in view of Lester. Withdrawal of this rejection is respectfully requested.

Park, as cited in combination with both Henson and Lester, fails to provide the suggestion and motivation to combine with other references to teach the modification claimed in

Claim 1. Park recites a portable dirt scrubber, but fails to disclose the desirability of an extension for the handle. And, Park specifically fails to disclose or envision pins formed at the proximal end of the handle for engaging the slots formed on an extension. Park is silent as to these modifications. Arguably, Park teaches away from the use and desirability of an extension, considering that attaching an extension to the handle would interfere with the use and function of the device. For example, if an extension arm was coupled to the handle (50), the control unit (40) would be blocked, and thus, actuation of the device would be impaired considerably. For these reasons, Park does not suggest the combination as cited, thus Claim 1 (as embodying the subject matter of former and now canceled Claim 2) is patenably distinguishable over the combinations of Park in view of Henson, and Park in view of Lester. Claims 3-7 directly or indirectly depend from independent Claim 1, and as such, are also patentably distinguishable over the combinations of Park in view of Henson, and Park in view of Lester. Withdrawal of this rejection is respectfully requested.

In regard to the several rejections of the claims under 35 U.S.C. § 103(a), based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed

combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a lawn chair and screen cover system having an elongated support member affixed to a lawn chair, a screen supported by the support member and bands radiating from the support member, a removable protective cover coupled to the screen itself, the screen having an entrance and an opening. Uniroyal, Inc. v. Rudkci-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge

learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

II New Claims 8-19 are considered patentably distinct over the prior as being unanticipated and non-obvious improvements of the art. For example, Claim 8 recites (quoting for convenience):

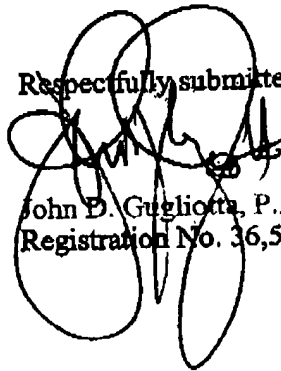
8. A cleaning apparatus comprising:
 - a handle having:
 - an operational control;
 - a pair of pins formed at a proximal end of said handle;
 - an internal compartment housing a power source and motor, said power source and motor electrically coupled to said operational control;
 - a cleaning head removably attached to a distal end of said handle; and
 - a first extension arm, a second extension arm, and a third extension, wherein each one of said arms comprises:
 - a cavity formed at a distal end of said arm, said cavity receiving said proximal end of said handle;
 - a pair of slots formed circumjacent said cavity, each one of said slots receiving and coupling with each one of said pins.

Thus, Claim 8 describes a cleaning apparatus having a handle, a cleaning head and three extension arms. The cleaning head is coupled to the handle. The handle has a control, electrical coupling between a battery, a motor and the control. The handle also has pins formed at the proximal end for engaging slots formed on one of the extension arms. Each extension arm has a cavity formed at the distal end of the arm for receiving the proximal end of the handle, and slots formed circumjacent the cavity for engaging the pins of the handle. This combination of elements is not disclosed in a single reference, and is not disclosed by a combination of references. Thus, the combination is patentably distinguishable over the art cited. Claims 9-15 depend directly or indirectly from Claim 8, thus, Claims 9-15 are also considered patentably distinct over the prior art cited.

Furthermore, the combination of extension arms is not disclosed in the references, specifically the combination of linear, curvilinear and angled extension arms, wherein the arms may be directly coupled to the handle, interchangeable, or used in combinations to achieve optimal angular positioning of the head.

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John D. Gugliotta', is written over the typed name and registration number.

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